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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,597	02/04/2004	James D. Ralph	SPINE 3.0-447 CONT	3441
51640	7590	05/27/2009	EXAMINER	
SPINE MP			HOFFMAN, MARY C	
LERNER, DAVID, et al.				
600 SOUTH AVENUE WEST			ART UNIT	PAPER NUMBER
WESTFIELD, NJ 07090			3733	
			MAIL DATE	DELIVERY MODE
			05/27/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/771,597	Applicant(s) RALPH ET AL.	
	Examiner MARY HOFFMAN	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/13/2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-11 is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 2,3 and 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/13/2009 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

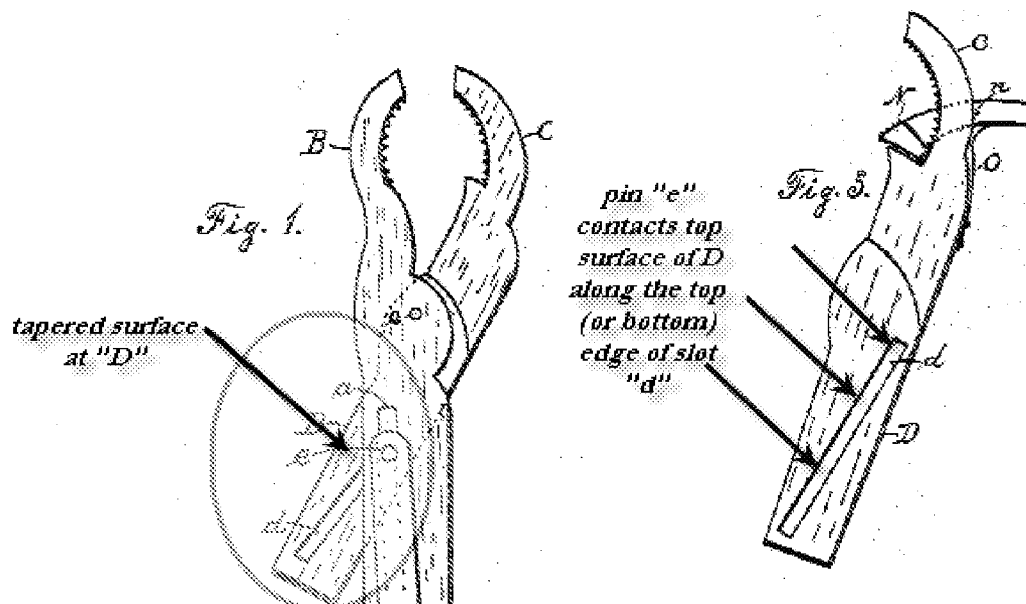
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koch (U.S. Patent No. 640,308) in view of Yamada et al. (U.S. Patent No. 4,304,157).

Koch discloses an instrument for holding an intervertebral spacer, the instrument comprising a shaft having a proximal end forming a handle (A), and a distal end forming a claw subassembly; the claw subassembly including a first pincer (B) which is fixed at the distal end of the shaft and a second pincer (C) which is pivotally coupled with the first pincer for rotating into and out of spacer holding association with the first pincer;

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and an actuation mechanism (I) for selectively rotating the second pincer, wherein the first and second pincers have opposing inner curved surfaces that extend to a distal-most end of the instrument. A sliding element (e, g) is mounted to the shaft and is selectively movable by pushing, in at least a distal direction by a force sufficient to overcome the bias of the second pincer, and the second pincer including a tapered surface which is contacted by a corresponding surface of the sliding member (see marked-up figure below). The contacting causes the second pincer to pivot relative the first pincer.



Koch discloses the claimed invention except for the pincers being biased outwardly.

Yamada et al. discloses biasing in tools to make the tool readily useable without any preparatory procedure.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the tool of Koch with pincers biased in view of Yamada et al. in order to make the tool readily useable without any preparatory procedure.

Allowable Subject Matter

Claims 6-11 are allowed.

Claims 2-3, 5 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments see pages 6-7, filed 03/13/2009, with respect to claims 1-9 have been fully considered and are persuasive. The rejection of claim 1-9 under Kelly (U.S. 5,122,130) has been withdrawn. As discussed during the interview on 3/13/2009, the first pincer of Kelly is not "in a fixed position relative the said shaft." While the first pincer may be considered "fixed" or attached, its position relative the shaft is not "fixed."

Applicant's arguments, see page 8, filed 03/13/2009, with respect to claims 6-11 have been fully considered and are persuasive. The rejection of claims 6-11 under Koch (U.S. 640,308) in view of Yamada et al. (U.S. 4,304,157) has been withdrawn. In particular, the sliding element of Koch is not translatable into and out of contact with the tapered surface.

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Applicant's arguments other filed 03/13/2009 have been fully considered but they are not persuasive. As seen in the above marked-up figure, Koch does disclose a tapered surface "D." The pin "e," which can be considered part of the sliding element, is in contact with surface 'D.'

In addition, Applicant argues that the structure of Koch would not benefit from having a second pincer biased. The examiner respectfully disagrees. Biasing tools is well known in the art, and biasing makes tools more readily useable.

The rejection is deemed proper.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARY HOFFMAN whose telephone number is (571)272-5566. The examiner can normally be reached on Monday-Thursday 10:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mary C. Hoffman/
Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733